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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 01/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,530

Applicant(s)

MAUBRU ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 13,15,23-29 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12,14,16-22 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Applicant's response of 30 November 2001 is entered. Claims 37-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Claims 13, 15, and 23-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction and election requirement in Paper No. 7, submitted 30 November 2001. Claims 1-12, 14, 16-22, and 30-36 are pending.

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-36 in Paper No. 7 submitted 30 November 2001 is acknowledged. The traversal is on the grounds that it would not be unduly burdensome to search and examine the subject matter of all the claims as written. Applicant asserts that the subject matter of Groups II and III would appear to encompass the search and examination of the subject matter of Group I because all the claims recite at least one starch of specified formulae and a washing base. This is not found persuasive because a search including the limitations of Groups II or III, including for example the terms "keratin, hair, cosmetic, or make-up" would not necessarily yield the prior art relevant to Group I. For example, the elected species of starch is disclosed by Koubek et al (US Pat. 5,641,349; Example 24) as a component in water-based adhesives used for example in cigarettes. It is the position of the examiner that a reference such as Koubek, disclosing the use of the elected species of starch,

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would not necessarily be found in a search incorporating the limitations of Groups II or III. Therefore, it is the position of the examiner that the searches involved for each of Groups I, II, or III are not co-extensive with the others and represent a serious burden. The requirement is still deemed proper and is therefore made FINAL.

2. With respect to the requirement for an election of species, applicant elects the amphoteric starch of formula (I) wherein R, R', and R'' are hydrogen and n is equal to 2. It is noted that formula (I) does not contain an R'' group, so this limitation is not considered by the examiner to be part of the elected species. Applicant also elects alkyl ether sulfate salts as the species of anionic surfactants. Applicant further elects the species of hydroxyethylcellulose crosslinked with epichlorohydrin and quaternized with trimethylamine as the species of cationic polymers. Additionally, applicant elects polydimethylsiloxanes as the species of silicone, and coconut monoisopropanolamide as the species of additive. The requirement for an election of species is traversed on the grounds that the species disclosed do not represent an unreasonable number of species. It is noted that the claimed amphoteric starches alone encompass at least hundreds, if not thousands, of possible compounds. Combined with the claimed washing bases, silicones, cationic polymers, and additives, the potential number of claimed compositions is vast. Therefore, it is the position of the examiner that the number of claimed species represent a serious burden with respect to the search involved. The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

3. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper (see page 6, lines 2-5; page 12, lines 7-12; page 15, lines 13-14; page 16, lines 1-3 and 12-14; page 17, lines 19-20; page 18, lines 9-10 and 17-18; page 20, lines 14-16; page 23 lines 6-7; page 25, lines 3-4; page 27, lines 1-3; page 28, lines 6-9; page 32, lines 16-18 and 22-23; and page 33, lines 3-4 and 10-11). The material is considered to be essential because it refers to embodiments of the invention rather than mere background. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### ***Double Patenting***

4. Applicant is advised that should claim 1 be found allowable, claims 35 and 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

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one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12, 14, 16-22, and 30-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 35, and 36 are rejected for being vague and confusing due to the phrase "fatty acid soaps". It is noted that applicant defines the phrase on page 3, lines 17-18 of the specification. However, it is unclear to the examiner how salts of alkali metals, for example NaCl, could constitute a "fatty acid soap". Clarification is required.

8. Claims 1, 35, and 36 are rejected for containing improper Markush groups due to the definition of R" which is defined by the phrase "which may be identical or different, are each chosen from a hydrogen atom and alkyl groups comprising from 1 to 18 carbon atoms". The definition of R" is indefinite in the use of the term "comprising" which renders the structure of R" ambiguous. It is the position of the examiner that discrete, non-polymeric alkyl groups are ambiguous when defined as "comprising" a certain number of carbon atoms. The examiner respectfully suggests the substitution of the term "having" for the term "comprising".

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9. Claim 12 is rejected due to the term "derivatives". The metes and bounds of the term are unclear, rendering the claim indefinite.
10. Claim 30 is rejected due to the term "polydimethylsiloxaness". The term appears to be a typographical error.
11. Claim 33 is rejected due to the phrase "from from" (third line of the claim). The rejection can be obviated by removal of the duplicate term.
12. Claim 33 is rejected for being confusing in listing further additives that may include fatty acids. However, the inclusion of fatty acids would appear to be inconsistent with Claim 1 from which Claim 33 depends, which states the proviso that the compositions be free of fatty acid soaps. Clarification or removal of fatty acids from the list of additives is required.
13. Any remaining claims are rejected for depending from indefinite base claims.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-10, 19-22, 30-32, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Villa et al (US Pat. 6,001,344) in view of Sweger et al (US Pat. 5,482,704).

17. Villa teaches liquid cleansing compositions including liquid shower gel compositions (see abstract and col. 1, lines 6-15). Comparative examples include sodium laureth sulfate (an alkyl ether sulfate), dimethicone (a polydimethylsiloxane with trimethylsilyl end groups), and Carbopol® (see col. 7-8, lines 59-67 through col. 9-10, lines 1-20). The reference lacks the use of amphoteric starches as claimed.

18. Sweger teaches the use of amphoteric starches including the claimed species in cosmetic compositions (see abstract and Example 1, col. 6, lines 44-67, referred to as Ceba-starch). Sweger teaches that Ceba-starch replacing Carbopol® had the best skin feel and appearance (see col. 8, lines 35-50). Additionally, Sweger teaches that Ceba-starch is superior to Carbopol® with regard to separation of layers and viscosity (see col. 9, lines 1-6).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Villa by the substitution of Ceba-starch for Carbopol® as taught by Sweger in order to benefit from the improved properties of Ceba-starch as compared to Carbopol® as taught by Sweger.



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20. Claims 1-12, 14, 16-18, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (US Pat. 5,720,964) in view of Sweger et al (US Pat. 5,482,704).

21. Murray teaches hair conditioning compositions (see abstract). Murray teaches that cationic cellulose polymers suitable in the compositions include hydroxyethylcellulose reacted with trimethyl ammonium substituted epoxide, referred to as polyquaternium 10 (see col. 3, lines 35-41). A preferred cellulose ether is Polymer JR400 (see col. 4, lines 30-31). Murray further teaches the use of Carbopol® (see col. 4, lines 50-56). Example 3 comprises sodium lauryl ether sulfate (an alkyl ether sulfate), Polymer JR 400 (hydroxyethylcellulose reacted with trimethyl ammonium substituted epoxide), and Carbopol® 980. The reference lacks the use of amphoteric starches as claimed.

22. Sweger teaches the use of amphoteric starches including the claimed species in cosmetic compositions (see abstract and Example 1, col. 6, lines 44-67, referred to as Ceba-starch). Sweger teaches that Ceba-starch replacing Carbopol® had the best skin feel and appearance (see col. 8, lines 35-50). Additionally, Sweger teaches that Ceba-starch is superior to Carbopol® with regard to separation of layers and viscosity (see col. 9, lines 1-6).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Murray by the substitution of Ceba-starch for Carbopol® as taught by Sweger in order to benefit from the improved properties of Ceba-starch as compared to Carbopol® as taught by Sweger.

24. Claims 1 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saint-Leger (US Pat. 5,919,438) in view of Sweger et al (US Pat. 5,482,704).

25. Saint-Leger teaches dermatological/cosmetic compositions (see abstract). The compositions include shampoos (see examples, col. 4, line 1 through col. 5, line 44).

Saint-Leger teaches the use of those agents that are typically used in formulating dermatological/cosmetic compositions, including thickeners such as polyacrylic acids (see col. 3, lines 4-67). Carbopol® 980 is used as a thickener (see col. 5, lines 1-21).

Example 1 is comprised of sodium lauryl ether sulfate and coconut monoisopropanolamide (see col. 4, lines 1-23). The reference lacks the use of amphoteric starches as claimed.

26. Sweger teaches the use of amphoteric starches including the claimed species in cosmetic compositions (see abstract and Example 1, col. 6, lines 44-67, referred to as Ceba-starch). Sweger teaches that Ceba-starch replacing Carbopol® had the best skin feel and appearance (see col. 8, lines 35-50). Additionally, Sweger teaches that Ceba-starch is superior to Carbopol® with regard to separation of layers and viscosity (see col. 9, lines 1-6).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Saint-Leger by the substitution of Ceba-starch for Carbopol® as a thickener as taught by Sweger in order to benefit from the improved properties of Ceba-starch as compared to Carbopol® as taught by Sweger.


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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L. Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
Michael A. Willis  
Examiner  
Art Unit 1619

January 14, 2002

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER